

## REMARKS

Applicant has studied the Final Office Action dated March 12, 2007, and the Advisory Action dated July 5, 2007. Claims 1, 3-6 and 9-13 are pending. Claims 1, 6, 9, and 13 have been amended. Claims 1, 6, 9 and 13 are independent claims. No new matter has been added as the amendments have support in the specification as originally filed.

It is submitted that the application, as amended is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### § 103 Rejections

Claims 1, 4-6, 9 and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schrader et al. ("Schrader" App. Pub. No. 2002/0166123) in view of Freeman et al. ("Freeman" U.S. Pat. App. Pub. No. 2001/0013123). Applicant respectfully disagrees with the Examiner's interpretation of Freeman and respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is well-settled law that to support a finding of obviousness, a reference must provide some motivation, working without the benefit of the applicant's specification, to make the necessary changes in the device disclosed in the reference. The mere fact that a worker in the art could modify the reference to meet the terms of the claims is not,

by itself, sufficient. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

It is respectfully noted that the Examiner asserts, at paragraph 3 on pages 3, 5, 7 and 9 of the Office action, that Schrader does not disclose preference extracting means adapted to extract a preference that is one of directly inputted by a user and automatically created from a watch record based upon specific digital broadcasts previously accessed by the user, as recited in independent claims 1, 6, 9 and 13. It is further respectfully noted that the Examiner cites the disclosure at paragraph 0031 of Freeman as curing the deficiency of Schrader based on the assertion that "it would have been obvious to one of ordinary skill in the art to modify the system of Schrader by obtaining the viewer preference information directly from the user or from the viewing history of the user as taught by Freeman". Applicant respectfully submits that one of ordinary skill in the art would **not** have looked to Freeman for motivation to modify the Schrader system.

It is respectfully noted that Freeman is directed to "MPEG storage/playback systems" and, specifically "the invention provides for a programming transmission center to maintain a single or multiple MPEG storage server environments." See, for example, paragraphs 0006, 0012, 0013, 0027, 0039, 0041, 0042, 0050, 0051, 0054 and 0057. It is respectfully submitted that nowhere in Freeman is applicability to "XML (Extensible Markup Language)-formatted broadcasting information" disclosed.

On the other hand, it is respectfully noted that independent claims 1, 6, 9 and 13 specifically recite that the extracting means adapted to extract a preference that is one of directly inputted by a user and automatically created from a watch record based upon specific digital broadcasts previously accessed by the user is applicable to metadata extracted from XML (Extensible Markup Language)-formatted broadcasting information. It is further respectfully noted that the Examiner, at paragraph 3 on pages 2, 5, 6 and 8 of the Office action, specifically relies on the disclosure in paragraph 0047 of Schrader

that "the received data may be transmitted as Extensible Markup Language (XML)" and the processing of "XML data" in order to assert Schrader against independent claims 1, 6, 9 and 13.

It is respectfully submitted that one of ordinary skill in the art would **not** be motivated to combine the teachings of Freeman related to "MPEG storage/playback systems" with the teaching of Schrader related to "XML data" to produce the present invention that recites extracting means adapted to extract a preference that is one of directly inputted by a user and automatically created from a watch record based upon specific digital broadcasts previously accessed by the user that is applicable to metadata extracted from XML (Extensible Markup Language)-formatted broadcasting information. It is further respectfully submitted that one of ordinary skill in the art would have to rely on impermissible hindsight regarding the present claims to find the requisite motivation to combine the asserted teachings of Freeman and Schrader.

Therefore, it is respectfully asserted that the combination of the Schrader and Freeman references is improper and, therefore, claims 1, 4-6, 9 and 11-13 are in condition for allowance. It is respectfully requested that rejection be withdrawn.

Notwithstanding that the combination of the Schrader and Freeman references is improper, independent claims 1, 6, 9 and 13 have been amended with this paper to recite Electronic Program Guide (EPG) information that is formatted in XML format. It is respectfully submitted that support for the amendments is found in the specification as originally filed at paragraphs 0044 and 0045.

It is respectfully submitted that neither Schrader nor Freeman discloses Electronic Program Guide (EPG) information that is formatted in XML format. Therefore, it is respectfully asserted that independent claims 1, 6, 9 and 13 are allowable over the asserted combination of references. It is further respectfully asserted that claims 4 and 5, which depend from claim 1, and claims 11 and 12, which depend from claim 9, also are allowable of the asserted combination of references.

Claims 3 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schrader in view of Freeman, as applied to claims 1 and 9 above, and further in view of Koreeda et al. ("Koreeda" U.S. Pat. App. Pub. No. 2002/0019979). Applicant respectfully traverses the rejection.

It is respectfully submitted that, in the absence of Freeman, Koreeda fails to cure the deficiencies of Schrader with regard to extracting means adapted to extract a preference that is one of directly inputted by a user and automatically created from a watch record based upon specific digital broadcasts previously accessed by the user that is applicable to metadata extracted from XML (Extensible Markup Language)-formatted broadcasting information and Electronic Program Guide (EPG) information that is formatted in XML format, as recited in independent claims 1 and 9. Therefore, it is respectfully asserted that independent claims 1 and 9 are allowable over the asserted combination of references, as are claim 3, which depends from claim 1, and claim 10, which depends from claim 9.

### CONCLUSION

In view of the above remarks, Applicant submits that claims 1, 3-6 and 9-13 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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